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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,563	03/09/2001	Raimond Lasar	01LASR01PN	7303
27579	7590	11/01/2005	EXAMINER	
LAWRENCE ROBERT BRANDT			REESE, DAVID C	
P.O. BOX 1937			ART UNIT	
SAXONVILLE, MA 01701			PAPER NUMBER	
			3677	
DATE MAILED: 11/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/803,563	Applicant(s) LASAR, RAIMOND	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-17, 19-24 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-17, 19-24 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's original amendment filed 8/15/2003

Status of Claims

- [1] Claims 1-4, 6-17, 19-24, 27-32 are pending.

Claim Rejections - 35 USC § 112

- [2] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 8/15/2003. Accordingly, the Examiner has withdrawn the 35 USC § 112 rejections.

- [3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

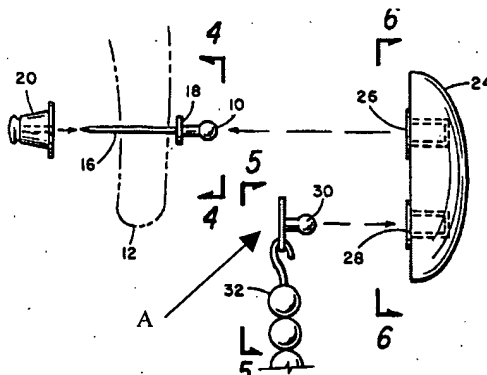
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [4] Claims 1, 14, 15, and 21 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Hernandez (U.S. Patent No. 4,783,974) because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Hernandez is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

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[5] As for Claim 1, Hernandez discloses a body decoration system wherein said system comprises a body piercing section (16), said body piercing section having a primary end, a secondary end (10), and a diameter; a fastening section (20), said fastening section having a diameter, said diameter of said fastening section being greater than said diameter of said body piercing section, a primary attachment, said primary attachment of said fastening section being detachably related in mating engagement with said primary end of said body piercing section; a head section (24), said head section having a secondary attachment (26), said secondary attachment of said head section being attached to said secondary end of said body piercing section, a primary attachment (28), said primary attachment of said head section providing a detachable mating engagement; and a decorative section (A), said decorative section having a primary attachment (30), said primary attachment of said decorative section being detachably related in mating engagement so said primary attachment of said head section, a decorative element (32), said decorative element being affixed to said primary attachment of said decorative section; whereby said decorative section may be removed and replaced with a different section without removing said head section or said fastening section from said body piercing section, see figure below.



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As it concerns claim 14, Hernandez's fastening section (20) is essentially spherical.

Regarding claim 15, said body piercing section (16) is a piercing pin.

[6] Claims 1, 2, 3, 6-10, 12, 13, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (U.S. Patent No. 4,195,492). Johnson discloses a body decoration system as claimed; wherein said system includes a body piercing section (2), said body piercing section having a primary end (4), a secondary end (12), and a diameter; a fastening section (6), said fastening section having a diameter, said diameter of said fastening section being greater than said diameter of said body piercing section, a primary attachment (8), said primary attachment of said fastening section being detachably related in mating engagement with said primary end of said body piercing section; a head section (15), said head section having a secondary attachment (S), said secondary attachment of said head section being attached to said secondary end of said body piercing section, a primary attachment (P), said primary attachment of said head section providing a detachable mating engagement; and a decorative section (14), said decorative section having a primary attachment (H), said primary attachment of said decorative section being detachably related in mating engagement so said primary attachment of said head section, a decorative element (Z), said decorative element being affixed to said primary attachment of said decorative section; whereby said decorative section may be removed and replaced with a different section without removing said head section or said fastening section from said body piercing section, see Fig. 1.

Re: claim 2, Johnson's decorative section (14) includes an axis of rotational symmetry, said primary attachment (H) of said decorative section being disposed along said axis of said

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decorative section. The head section includes an axis of rotational symmetry, said primary attachment of said head section being disposed along said axis of said head section; said axis of said head section lying along a central axis of rotational symmetry and said axis of said decorative section also lying along a central axis of rotational symmetry; said head section having a flattened area being defined by a plane which is normal to said central axis of rotational symmetry. The flattened area having an external diameter, a portion forming a central hollow area, said hollow portion having an internal diameter, said hollow portion having a base point disposed along said axis of said head section, said external diameter being somewhat larger than said internal diameter, a substantially circular shaped stop area (G), said stop area being created between said internal diameter and said external diameter. The primary attachment of said head section being positioned at said base point of said hollow portion in said head section; said decorative section includes a ring-shaped fastening section (Q) attached to said decorative element; said ring shaped fastening section being substantially centered about said central axis of rotational symmetry; said ring shaped fastening section being in contact with said circular shaped stop area when said primary attachment of said decorative section is engaged with said primary attachment of said head section; whereby said decorative section is strengthened and supported by said head section when said decorative section is mated with said head section.

Re: claim 3, Johnson's primary attachment of said head section includes a friction element, said friction element of said head section being frictionally related in mating engagement with said primary attachment of said decorative section.

Re: claim 6, Johnson's detachable mating engagement of said decorative section includes a section with gradually increasing diameter, and said detachable mating engagement of said

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head section includes a spring element (16), said section with said section with gradually increasing diameter of said detachable mating engagement of said decorative section being related in releasable locking engagement with said spring element of said detachable mating engagement of said head section.

Re: claim 7, Johnson's primary attachment of said decorative section has a first diameter, and said decorative element (Z) of said decorative section has a second diameter, said first diameter of said primary attachment of said decorative section and said second diameter of said decorative element of said decorative section being related by a ratio of 1, see Figs. 1 and 2. The applicant is also reminded that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Re: claim 8, Johnson's central hollow area of said head section is essentially conical joint shaped, said decorative section is essentially conical joint shaped, said conically joint shaped decorative section including a tip, and said primary attachment of said decorative section being attached at said tip of said conically shaped decorative section, said tip of said conically joint shaped decorative section being detachably related in mating engagement with said primary attachment of said head section, fig. 1.

Re: claim 9, said decorative section includes a mounting, said mounting having a decorative element attachment point (W), and a primary attachment point (U), said decorative element being permanently attached to said decorative element attachment point, and said primary attachment of said head section being attached at said primary attachment of said decorative section mounting.

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Re: claims 10 and 12, Johnson's body piercing section comprises a straight rod (2) having a circular cross-section.

Re: claims 13 and 24, Johnson's primary end of said body piercing section includes external threading, and said primary attachment of said fastening section includes external threading, said primary end of said body piercing section being removably threadedly related in mating engagement with said primary attachment of said fastening section, see Fig. 1. For the purposes of clarification, the Examiner has interpreted the grooves (i.e., 13 in Fig. 1) that make up the "snap-on" connector as threads.

Claim Rejections - 35 USC § 103

[7] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[8] Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez (U.S. Patent No. 4,783,974) in view of Erickson (U.S. Patent No. 4,781,036). Hernandez discloses a body decoration system substantially as claimed, wherein attachments are made using friction engaging members instead of internal/external threading on respective members. Erickson discloses an earring that teaches the use of identical internal and external threads as an art-recognized equivalent of frictional engaging members

[9] Claims 19, 27, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez (U.S. Patent No. 4,783,974) in view of Kowalski (U.S. Patent No. 5,074,128).

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Hernandez discloses a body decoration substantially as claimed (see paragraph 5 above) but fails to disclose the axis of the primary end of the body piercing section and the axis of the secondary end of the body piercing section forming an angle that is less than 180 degrees; wherein said angle is between 90 and 180 degrees. Kowalski discloses an earring having a body piercing section; wherein the angle claimed by the applicant is between 90 and 180 degrees, namely between 90 and 135 degrees. The applicant is reminded that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Re: Claim 32, wherein said body piercing section (16) further comprises a chord between said primary end (16) and said secondary end (10), said chord between said primary end (16) and said secondary end (10) of said body piercing section (16) having a length said length of said chord being greater than $\frac{1}{2}$ inch.

[10] Claims 20, 22, 23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez (U.S. Patent No. 4,783,974) in view of Erickson (U.S. Patent No. 4,781,036), further in view of Kowalski (U.S. Patent No. 5,074,128). Claims 20, 22, 23, and 28 are rejected in view of Erickson and Kowalski and as set forth above in paragraphs 5, 7, and 8. For the purposes of clarification, Hernandez's head section comprises an outside diameter; portion forming a hollow area, said hollow area of said head section having an inside diameter, said inside diameter of said hollow area being essentially 20% smaller than the diameter of said head section. The applicant is also reminded that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), see fig. 6. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to utilize, the teachings of Erickson, in regards to the use of identical internal/external threads as means of engagement, to provide Hernandez with a more secure and tactile means of engagement. The methods recited by the applicant in claims 22 and 23 are deemed inherent based on the structure of the prior art of record. Since the teachings of the references taken as a whole necessitate the steps described in said methods, it would have been obvious to one having ordinary skill in the art at the time the invention was made to carry out the necessary steps described by the methods.

[11] Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 4,195,492). Johnson's primary attachment of said decorative section includes a pin, and a friction element of said head section includes a material to frictionally secure said pin. Johnson does not disclose the material used in the head section. However, the applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). As it concerns claim 5, Johnson's assembly includes a threaded pin, and the primary attachment of the head section includes external threading. However, the applicant is reminded that the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

[12] Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 4,195,492) in view of Kowalski (U.S. Patent No. 5,074,128). Johnson discloses a body decoration system having a body piercing section comprising a straight rod. Kowalski

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discloses an earring teaching the use of a curved rod as a body piercing section. The applicant is reminded that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Response to Arguments

[13] Applicant's arguments filed 8/15/2003 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. To begin, a majority of the applicant's initial and lasting arguments are primarily focused on the examiner's appointment of item 24 of Hernandez as the "head" section as claimed. The applicant states that such an appointment is erroneous as 24 of Hernandez is designed to be "break away" in nature, and is therefore not the head section of the instant invention. This is irrelevant, as it the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Hernandez does indeed provide the structural limitations as currently claimed, regardless of whether or not the "head" structure as deemed by the examiner is "break away" in nature. What is pertinent in the instant case is that the prior art satisfy the structural limitations of the instant claims, and in this case, Hernandez does indeed anticipate. Further, the structural limitations of the term "head" are only as limiting as the structure that is provided with regard to said "head"; and therefore, it is irrelevant what the examiner appoints as "head" so long as the term properly anticipates the structural limitations of the instant claim. Thus, though the examiner and applicant may have different views on what the term "head" refers to, what's relevant is that claimed, and consequently the term "head" is

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indeed anticipated by Hernandez. The same argument above can be applied to the applicant's refutation of prior art of Johnson as well.

[14] Applicant's arguments filed 8/15/2003 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. In response to applicant's refutation of the instant claims initially on the terms of the "head" discussion as viewed above earlier, it is pertinent to point out that it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In the case of jewelry, even more so, it is quite obvious to have different fastening means (friction, threads, etc); as well as diverse material, size, and shape modifications. In addition, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In *re Bozek*, 163 USPQ 545 (CCPA) 1969.

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Conclusion

[15] Applicant's amendment (addition of Claim 32) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


[16] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR


ROBERT J. SANDY
PRIMARY EXAMINER